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| 10/696,658 | 10/29/2003 | LeTica Lee | 303089.3010134 | 7779 |
| 44331 | 7590 | 06/01/2006 | EXAMINER | |
| HISCOCK & BARCLAY, LLP 2000 HSBC PLAZA ROCHESTER, NY 14604-2404 | | | MERCIER, MELISSA S | |
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1615

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,658

Applicant(s)

LEE, LETICA

Examiner

Melissa S. Mercier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Summary

Claims 1-18 are pending in this application. Claims 1-18 are rejected.

Claim Objections

Claim 8 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim which does not refer to a preceding claim. Claim 8 is dependent on the lipstick composition of claim 9. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Applicant is advised that should claims 1-9 be found allowable, claims 10-18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The specification does not offer any description/guidance of what distinguishes a lipstick composition from a cosmetic composition.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. The term "at least about" is a relative term, which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. It is unclear to the examiner as to what the percentages the applicant is claiming with the recitation of the limitation "at least about 0.001 –10.0 percent by weight".

Claim 7 and 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The essential oils are not pure if they are mixed with a lipstick base as claimed in Claim 1. Further, the essential oils being 100% would be an inherent property of the oils.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 10, and 14 rejected under 35 U.S.C. 102(b) as being anticipated by Morshauser et al, (US Patent 3,479,429). '429 teaches a cosmetic preparation in the form of a lipstick having a base composition comprising "caster oil, candelilla wax, lanolin, carnauba wax, ozokerite, beeswax, and isopropyl myristate" (column 5, lines 45-

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55). '429 also teaches "flavoring such as synthetic aromatics, essential oils, or other similar materials may also be included if desired" (column 6, lines 5-7).

Claims 1-2, 5, 10-11, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Slimak. (US Patent 4,793,991). Slimak teaches a hypoallergenic cosmetic consisting of lip balms and lipsticks. One object of the invention is to "provide cosmetic compositions of beeswax and oil, for use as a lip balm" (column 1, lines 50-53). Example 3 of '991 describes eucalyptus beeswax and sunflower oil being combined to form a lip balm, lipstick base and a cosmetic composition. (column 2, lines 30-35).

Claims 1-3, 5-6, 10-12, and 14-15 rejected under 35 U.S.C. 102(b) as being anticipated by Wachter et al. (US Patent 6,964,775). '775 teaches a decorative cosmetic preparation comprising waxes, including candelilla wax, carnauba wax, beeswax, and petrolatum (column 6, lines 1-11), insoluble light protection pigments including iron oxides (column 7, lines 17-21), and natural and synthetic scent substances (perfumes) including lavender, jasmine, ylang-ylang, bergamot (column 8, lines 47-55). '775 also teaching in table 1 that the perfume content of their nurturing lipstick (7) and decorative lipstick (8) is 0.4% percent weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1-2, 4, 10-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud (US Patent 5,932,197) in view of Lane (US Patent 5,503,825).

Arnaud teaches a cosmetic composition provided in the form of a cosmetic, pharmaceutical or hygienic composition, which is to be applied on the lips of the face (column 3, lines 22-27). The composition can comprise oils, such as jojoba oil (column 4, line 11), waxes, such as beeswax, carnauba, and candelilla (column 4, lines 18-27), inorganic pigments, such as titanium dioxide and iron oxide (column 4, lines 53-55), and fillers, such as kaolin (column 5, line 2).

Arnaud does not teach the use of aloe vera extract in its cosmetic composition.

Lane teaches a lip balm composition comprising aloe vera (abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the aloe vera taught by Lane in the preparation of the lipstick composition of Arnaud. The applicant would have been motivated to combine the teachings of Arnaud with Lane in order to obtain a lip stick with "additional healing

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properties which feels good and makes the lips feel smoother and moister" (Lane, column 2, lines 39-41).

It is further determined that applicant would have had a reasonable expectation of success that the formulation would succeed as a lip stick since both Arnaud and Lane are drawn to lip stick/gloss compositions.

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckers et al (US Patent 6,372,234) in view of Hyldgaard et al (US Patent 6,342,208), further in view of Slimak (US Patent 4,793,991), Lu et al. (US Patent 6,866,856), and Perricone et al. (US Patent 6,162,419)

Decker teaches emulsions that comprise oil bodies, which can be used in make up products such as lip-glosses. Deckers teaches that the emulsion comprises:

- a. suitable oil bodies comprising: prunus dulic (almond), persea (avocado), castor oil (palm christi oil), evening primrose, and limnethes albo (meadowfoam) (column 8, lines 5-23)
- b. non-ionic surfactants comprising: sucrose esters (column 15, line 21)
- c. moisturizers comprising: aloe vera (column 16, line 2)
- d. emollients comprising: cocoa butter, shea butter, avocado, evening primrose, and meadowfoam seed (column 16, lines 33-40).
- e. vitamin actives comprising: ascorbyl palmitate and vitamin E (column 21, lines 46-48)

Deckers does not teach a composition which can be used on the lips comprising: beeswax, rosehip, Neem, DMAE, and black willow bark.

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Hyldgaard teaches oil in water emulsion for application on a skin surface. The emulsion contains lipids comprising: rose hip, rosemary, and willow bark (column 8, lines 25, 39, and 43).

Slimak teaches a lip balm/stick and other cosmetic preparations comprising beeswaxes (abstract).

Additionally, Lu teaches a cosmetic composition comprising azadirachtin, which is to be applied to the skin. The composition has been found suitable for use in treating dermatological conditions of the skin in numerous areas of the body (column 4, lines 54-57).

Additionally, Perricone teaches a dermatological composition comprising dimethylaminoethanol with is useful in shortening subcutaneous muscles (column 2, lines 24-26).

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of components found in cosmetic formulations. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

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By combining the teaching described, one of ordinary skill in the art would have a reasonable expectation that the components selected would make a lipstick/cosmetic formulation with the desired effect.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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